

All of the pending claims have been rejected under 35 USC §102 and/or 103 based on various references cited by the Examiner, including U.S. Patent No. 5,970,469 to Scroggie et al. (hereinafter "Scroggie"), U.S. Patent No. 5,537,314 to Kanter (hereinafter "Kanter"), U.S. Patent No. 6,049,778 to Walker (hereinafter "Walker '778"), PCT No. WO 96/31848 to Burdon et al. (hereinafter "Burdon"), the article "Can mixing cookies with online marketing be a recipe for heartburn?" by Ed Foster (hereinafter "Cookie Article"), the article "Cellular Wrong Signals," by Henry Gilgoff (hereinafter "Nynex"), and the article "Credit Card firms drive down Costs" by Stephen Ellis (hereinafter "Ellis").

Applicants respectfully submit that the claims, as amended, are in condition for allowance. Reconsideration is respectfully requested.

A. Objection to Disclosure

The Examiner objected to the disclosure, stating that it appears that priority to the wrong application number has been claimed. Applicants thank the Examiner for noting this error, and Applicants have corrected the disclosure through the amendment above to cite the correct application number -- 09/166,367.

B. Information Disclosure Statement Defects

The Examiner stated that the information disclosure statement filed September 10, 1999 fails to comply with 37 CFR 1.98(a)(2). Applicants have filed on concurrent date herewith a supplemental information disclosure statement containing the references disclosed in the September 10, 1999 information disclosure statement. Applicants respectfully request that the Examiner initial each of the references on the submitted information disclosure statements.

C. Section 112 Rejections

Claims 29, 31, 49 and 50 stand rejected as being indefinite. Applicants have amended claims 29 and 49 in accordance with the Examiner's helpful comments. As such, Applicants submit that the Examiner's Section 112 rejections have been overcome.

D. Double Patenting Rejections

Claims 2, 12, 21-23, and 31 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over one or more claims of copending Application Nos. 09/219,267; 09/322,351; 09/223,903; or 09/166,367. Although Applicants do not agree with these rejections, four terminal disclaimers in compliance with 37 CFR 321(c) are being filed concurrently herewith to expedite prosecution of the present application, and Applicants submit that these rejections have been overcome.

E. Section 102 Rejection of Claims 1, 3-4, 8-21, 28-30, 32-36, 51-56

The Examiner rejected claims 1, 3-4, 8-21, 28-30, 32-36, and 51-56 under 35 US §102(e) as being anticipated by the Scroggie patent. Applicants respectfully traverse the Examiner's rejection.

The claims rejected under Section 102 include independent method claims 1 and 36, as well as independent apparatus or computer readable medium claims 51-56, which generally correspond to one of method claims 1 and 36. Applicants respectfully submit that independent claims 1 and 36 are not anticipated by the Scroggie patent because it does not teach or suggest all of the features of either independent claim. Specifically, Scroggie does not teach or suggest features generally directed to "providing, in response to the received information, an indication of an offer for a subsidy from a second vendor," as in independent claim 1. Independent claim 36 contains a similar feature concerning an "offer for a subsidy from a second vendor."

Scroggie discloses a system and method for "delivering purchasing incentives and a variety of other retail shopping aids through a computer network Abstract. "The incentives are distributed in such a way that they may be redeemed only at a specific retailer selected by each customer." Col. 1, lines 41-43. The incentives "are derived from two sources: product manufacturers and retailers," col. 2, lines 38-39, and are "coupon offers, rebate offers, or information offers. . . ." Col. 5, lines 63-65. Figure 11 of Scroggie, which the Examiner cited in connection with dependent claim 2 1, depicts a coupon. Scroggie does not, however, disclose the "offer for a subsidy" as claimed in Applicants' claims 1 or 36.

In order to further prosecution of this application, Applicants have amended independent claims 1 and 36 to state that "the offer for the subsidy is an offer for a reduction in

price relative to the total price." The total price is for "at least one item the customer desires to purchase from the first vendor," and the offer for the subsidy is "from a second vendor" in both claims 1 and 36. (emphasis added). Applicants submit that the "offer for a subsidy from a second vendor" of claims 1 and 36 is not disclosed in the Scroggie patent or in the other cited references. Applicants respectfully request, therefore, that the Examiner's Section 102 rejection be removed. Claims 3-4, 8-21, 28-30, and 32-35 depend directly or indirectly from independent claim 1. The above comments regarding claim 1, therefore, apply equally to these claims. Independent claims 51-56 correspond to one of claims 1 or 36, and the above comments regarding claims 1 and 36 apply to these claims as well. Applicants have amended claim 35 in accordance with the amendments to claim 1. Applicants respectfully request removal of the Section 102 rejections for the above stated reasons.

Applicants also note that, for each independent claims that have been amended, the location of the element beginning with "receiving an indication" has been changed. This change has been made solely for readability and has not been made to overcome any of the Examiner's rejections.

F. Section 103 Rejection of Claims 2, 5-7, 21-27, 31, 37-42, 49-50, 57-65, and 72-74

Claims 31, 41-42, and 60-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie. In addition, claims 2, 5-7, 21-27, 31, 37-40, 49-50, 57-59, and 72-74 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie in view of one or more of the following references: the Kanter patent, the Walker '778 patent, the Cookie Article, the Nynex article, and the Ellis article. Applicants respectfully traverse the Examiner's Section 103 rejection.

Claims 2, 5-7, 21-27, 31, 37-42, 49-50, 57-65, and 72-74 contain independent method claims 37, 41-42, and 49. Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness with respect to these claims. With respect to independent claims 37 and 49, there is no suggestion or motivation in Scroggie, Kanter, or the knowledge generally available to one having ordinary skill in the art of "an offer for a subsidy from a second vendor," as in claims 37 and 49. Similarly, with respect to independent claims 41 and 42, there is no suggestion or motivation in either Scroggie or the knowledge generally available

to one having ordinary skill in the art to display, via a Web page on the Web site or via a POS terminal, "an indication of the offer for the subsidy from the second vendor," where the Web site or POS terminal is "of a first vendor," as in claims 41 and 42. (emphasis added). For these reasons, Applicants respectfully request that the Examiner remove the Section 103 rejections.

1. Independent Claims 37 and 39

Independent claims 37 and 49 were rejected over Scroggie in view of Kanter. The Kanter patent discloses a credit accumulation and accessing system for a plurality of sponsoring companies and participants. (Abstract). A participant of the Kanter system receives a card that allows the participant to realize "multi-level credit and/or awards at multiple sponsoring companies." (Col. 16, lines 41-42). Participants earn commissions (i.e., such as points) when purchases are made at sponsoring companies. (Col. 21, lines 9-67). "Sponsoring companies can post credit and/or awards to participants' accounts and designate at which sponsoring company location(s) the credit and/or awards can be redeemed." (Col. 16, lines 53-56).

Nothing in Kanter discloses or suggests an act of determining or providing an "offer for a subsidy from a second vendor," as in Applicants' independent claims 37 and 49. Instead, Kanter merely discloses a system that allows a participant to earn commissions through purchases at sponsoring companies and then redeem those commissions by receiving a discount off later purchases at a sponsoring company. Kanter does not, in any manner, disclose the "offer for a subsidy from a second vendor" as in claims 37 and 49. At best, to the extent Kanter discloses any type of offer or discount at all, it is merely a discount at a sponsoring company that is received through the accumulation of "commissions" or points from previous purchases, and such a discount is not output during the first transaction. Similarly, as discussed above with respect to claim 1, nothing in the Scroggie patent discloses the "offer for a subsidy from a second vendor" as contained in Applicants' independent claims 37 and 39.

In order to further prosecution of this application, Applicants have, nevertheless, amended independent claims 37 and 49 to state that "the offer for the subsidy is an offer for a reduction in price relative to the total price." The total price is for at least one item the customer has purchased (claim 37) or desires to purchase (claim 49) from the "first vendor," and the offer for the subsidy is "from a second vendor" in both claims 37 and 49. (emphasis added). Applicants submit that the "offer for a subsidy from a second vendor" of claims 37 and

49 is not disclosed in the Scroggie patent, the Kanter patent, or in the other cited references. Applicants respectfully request, therefore, that the Examiner's Section 103 rejection be removed.

2. Independent Claims 41 and 42

Independent claims 41 and 42 were rejected as being obvious over Scroggie. Applicants submit that there is no suggestion or motivation in either Scroggie or the knowledge generally available to one having ordinary skill in the art to display, via a Web page on the Web site or via a POS terminal, "an indication of the offer for the subsidy from the second vendor," where the Web site or POS terminal is "of a first vendor," as in claims 41 and 42. (emphasis added). For these reasons, Applicants respectfully request that the Examiner remove the Section 103 rejections.

Applicants respectfully submit that the Examiner has mischaracterized the Scroggie reference in rejecting claims 41 and 42. In particular, the Examiner cites Figure 5, item 142 of Scroggie as disclosing "displaying, via a Web page on the Web site, an indication of the offer for the subsidy from the second vendor." October 10 Office Action at 17. With respect to claim 42, the Examiner cites the Abstract and Figure 13, item 312 as disclosing "outputting at the POS terminal an indication of the offer for the subsidy from the second vendor." None of the cited sections of Scroggie, however, disclose outputting an offer for the subsidy from the second vendor at a Web site or POS terminal of the first vendor, as claimed in claims 41 and 42. Accordingly, Applicants respectfully traverse the Examiner's Section 103 rejection of claims 41 and 42 and request that the Examiner cite appropriate references to support these rejections, as required by MPEP 2144.03.

3. Apparatus, Computer Readable Medium, and Dependent Claims

Independent claims 57-59 contain similar features as claim 37, and independent claims 72-74 contain similar features as claim 49. The above comments regarding independent claims 37 and 49 therefore apply to these claims as well. Claims 60-65 are apparatus or computer readable medium claims that correspond to either claim 41 or claim 42, and the above comments regarding claims 41 and 42 therefore apply to these claims as well. Applicants, therefore, respectfully request removal of the Section 103 rejections for independent claims 57-65 and 72-74.

Dependent claims 2, 5-7, 21-27, 31, 38-40, and 50 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Scroggie in view of one or more of the following references: the Kanter patent, the Walker '778 patent, the Cookie article, the Nynex article, and the Ellis article. As discussed above, the Kanter patent does not disclose the "offer for a subsidy from a second vendor" as in Applicants' claimed invention. Applicants also submit that none of the other cited references, Walker '778, the Cookie Article, the Nynex article, and the Ellis article, disclose an "offer for a subsidy from a second vendor" as in Applicants' claimed invention. The Nynex article, for instance, discloses an advertisement for cellular services that offers a "free" phone in exchange for a two-year contract for cellular phone services. The Nynex article, however, does not disclose an "offer for a subsidy from a second vendor" as claimed in Applicants' claimed invention. The Nynex article is, in fact, silent as to any second vendor – only one vendor is mentioned in the Nynex article. In addition, in the incentive scheme of the Nynex article, the incentive offered is an open offer that is provided at no particular time to the customer and is not based on any information received. However, in the claimed invention, the offer for the subsidy is provided "in response to the received information" – i.e., at a different time than when the customer decides to purchase the first item and based on the received information relating to customer activity. Applicants submit, therefore, that Nynex does not disclose the "offer for a subsidy" as in Applicants' claimed invention.

G. Section 103 Rejection of Claims 43-48 and 66-71

Claims 43-44, 47-48, and 66-71 were rejected under 35 U.S.C. 103(a) as being unpatentable over Burdon in view of Kanter. In addition, claims 45 and 46 were rejected under 35 U.S.C. 103(a) as being obvious over Burdon and Kanter in view of the Nynex article.

Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness with respect to claims 43-44, 47-48, and 66-71. With respect to independent claims 43, there is no suggestion or motivation in Burdon, Kanter, or the knowledge generally available to one having ordinary skill in the art of an act of "transmitting via the IVRU an indication of the offer for the subsidy from the second vendor" where the IVRU is "of a first vendor" as in claim 43. With respect to claim 44, there is no suggestion or motivation in

Burdon, Kanter, or the knowledge generally available to one having ordinary skill in the art of "an offer for a subsidy from a second vendor" where the offer for the subsidy is "for a reduction in price relative to the total price."

Burdon discloses a method of "providing telecommunications rewards to a member comprising the steps of generating a point-of-sale transaction, relating the point-of-sale transaction to a member of telecommunications awards, [and] determining value of reward in dependence upon the point-of-sale transaction." Page 1, lines 21-25. The Examiner cited page 36, line 13 et seq., which discloses that a partner may provide reward units in exchange for answering a survey or participating in a game.

Nothing in either Burdon or Kanter discloses receiving "information relating to customer activity with an IVRU of a first vendor" and then "transmitting via the IVRU an indication of an offer for the subsidy from the second vendor" as in Applicants' independent claim 43. The cited sections of Burdon disclose a reward program where reward units may be earned in exchange for answering a survey or participating in a game. There is no offer for a subsidy in Burdon as in Applicants' claimed invention. In Applicants' claimed invention in claim 43, a "second price being less than the total price" is charged to the credit card account for the "at least one item having an associated total price" if the "offer is accepted." A subsidy for the purchase made at the "IVRU of a first vendor" is therefore consummated if the "offer for a subsidy from a second vendor" is accepted. Burdon does not disclose such an "offer for subsidy," but rather discloses a reward system that entitles a customer to a discount or free time for telecommunications services. Kanter, as discussed above, also discloses a system where participants earn commissions through purchases at sponsoring companies. Kanter does not, however, disclose the "offer for a subsidy from a second vendor" as in Applicants' claimed invention in claim 43.

Independent claim 44 also includes "an offer for a subsidy from a second vendor." In addition, claim 44 has been amended to include a feature that the offer for the subsidy is "for a reduction in price relative to the total price" of the at least one item at the first vendor. As discussed above, neither Kanter nor Burdon disclose such an "offer for a subsidy from a second vendor," and none of the cited references disclose an offer for a subsidy from a second vendor, where the offer for the subsidy is "for a reduction in price relative to the total price."

For the reasons stated above, Applicants respectfully request that the Examiner remove the Section 103 rejection for claims 43-44. Claims 47-48, which depend directly or indirectly from claim 44, include all of the features of claim 44, and Applicants therefore request that the Section 103 rejection be removed for these claims as well. Similarly, independent claims 66-71 contain features similar to those of claim 43 or claim 44, and Applicants therefore request removal of the Section 103 rejection for these claims as well. The above comments for claim 44 apply to dependent claims 45-46 as well, and Applicants therefore also request removal of the Section 103 rejection for these claims.

H. Newly Added Claims 75-80

Newly added claims 75-80 have been added to further claim the invention. Claims 75-80 each depend from one of the independent claims discussed above, and therefore the discussion above for the base claim applies to these claims as well.

I. Conclusion

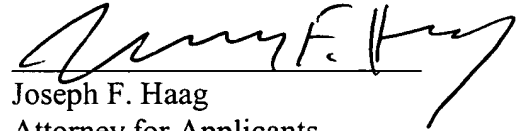
For the foregoing reasons it is submitted that all of the pending claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested. Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number (203) 461-7337 or via electronic mail at Alderucci@walkerdigital.com.

Applicants hereby petition for a one-month extension of time with which to respond to the Office Action. Please charge \$110.00 for this petition to our Deposit Account No. 50-0271 for this petition. In addition, six new dependent claims have been added, requiring a fee

payment of \$108.00, which Applicants hereby request to be charged to our Deposit Account No. 50-0271. If an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

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Date

Respectfully submitted,



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